

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stephen M. Drummond

Application No: 10/824,954

Filed: April 14, 2004

For: SYSTEMS AND METHODS FOR TRADING EMISSION
REDUCTION BENEFITS

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Art Unit: 3689

Confirmation No.: 7464

Examiner: Heidi M. Riviere

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the Final Rejection of February 11, 2009 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS

Claims 13-15, 20, 21 and 49 are pending in this application, of which claim 13 is independent.

I. Examiner's failure to show all of the limitations of claim 20 results in a failure to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

The Examiner's failure to show all of the limitations in claim 20 resulted in clear error. Specifically, claim 20 recites, *inter alia*, "providing the buyer with a listing that displays a plurality of emission reducing projects."

Although the Examiner concedes that Soestbergen fails to teach this limitation, he alleges that paragraphs 50 and 59 of Cogen do. *See Office Action of February 11, 2009, p. 7.* But, in actuality, the cited portions of Cogen merely disclose: "creating a record in a database for each VER," in which these records are used to "ensure compliance with regulatory requirements" during the transfer of mutual portfolio units (MPUs). *See para. 50, 56 of Cogen.* The records are "publicly available" and maintained in a "national registry." *See para. 59 of Cogen.*

Nowhere does Cogen teach or suggest a listing that “*displays a plurality of emission reducing projects*” to buyers. In other words, Cogen merely discloses creating records in a database for the purposes of complying with regulatory requirements. There is no teaching or suggestion, whatsoever, of providing a buyer with a listing of emission projects to be selected for purchase.

Thus, the Examiner’s failure to address all of the limitations of claim **20**, as required for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a) results in clear error.

II. Examiner’s failure to show all of the limitations of claim 21 results in a failure to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

The Examiner’s failure to show all of the limitations in claim **21** resulted in clear error. Specifically, claim **21** recites, *inter alia*, “*providing the buyer with an opportunity to search for the emission reducing project*” (emphasis added).

Although the Examiner concedes that Soestbergen fails to teach this limitation, he alleges that paragraphs 50 and 59 of Cogen do. *See Office Action of February 11, 2009, p. 7.*

As described under subsection I, paragraphs 50 and 59 of Cogen merely disclose creating records in a database for the purposes of complying with regulatory requirements. There is no teaching or suggestion, whatsoever, of an ability “*to search*” for a particular emission reducing project.

Thus, the Examiner’s failure to address all of the limitations of claim **21**, as required for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a) results in clear error.

III. Examiner’s failure to show all of the limitations of claim 13 results in a failure to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

The Examiner’s failure to show all of the limitations in claim **13** resulted in clear error. Claim **13** recites, *inter alia*:

providing the buyer with an emission retirement guarantee, wherein the emission retirement guarantee prevents the purchased amount of emission reduction benefit from being repurchased (emphasis added).

Although the Examiner concedes that Soestbergen fails to teach this limitation, he alleges that the cited portions of Cogen do. *See Office Action of February 11, 2009, p. 5.* But, in actuality, the cited portions of Cogen merely describe the following:

... [A] computer-based technique for receiving verified emission reductions (VERs) associated with emission reduction projects (ERPs) and converting the VERs into mutual portfolio units (MPUs) based on

predetermined factors. An emissions reduction portfolio database of MPUs is created... [para. 006]

... [A] party, such as a shareholder having an account in the portfolio, may submit VERS... associated with ERPs which may be subsequently converted to MPUs. The *party may redeem one or more MPUs at any time, such as for compliance or retirement purposes*... [para. 0020] (emphasis added).

Nowhere does Cogen teach or suggest providing a buyer with “*an emission retirement guarantee*” that “*prevents the purchased amount of emission reduction benefit from being repurchased*” (emphasis added).

At best, Cogen discloses redeeming a mutual portfolio unit (MPU) for retirement purposes. However, redeeming a MPU for retirement purposes does not automatically ensure that the corresponding ERP would not be repurchased. In other words, without an express “*guarantee*” preventing its occurrence, there is a possibility that the corresponding ERP may be repurchased at a later date.

Thus, the Examiner’s failure to address all of the limitations of claim **13**, as required for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a) results in clear error.

Respectfully submitted,

Date: June 17, 2009

Customer No: 63710

_____/Ruth J. Ma/_____
Ruth J. Ma, Reg. No. 55,414
Attorney for Applicant
Tel. No. (857) 413-2056